

Remarks

Applicant has amended claims 30 and 32 to correct a typographical error. Claims 4-6, 11, 15-17, 22, and 24-25 have been allowed. Claims 1-32 remain for consideration in this application.

Rejections Under 35 U.S.C. § 103

Claims 1, 2, 3, 7, 8, 10, 12, 13, 14, 18, 19, 20, 21, 23, 26, 27, 28, 29, 30, 31 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kitaoka* (U.S. Patent No. 6,400,659) in view of *Kita et al.* (U.S. Patent No. 5,798,161). Applicant once again traverses these rejections, and submits that no *prima facie* case of obviousness has been made in the Office Action.

The combination suggested by the Office Action would require substantial modification of *Kitaoka* that would change its principle of operation. MPEP § 2143.01 states in pertinent part:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In *re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

Every embodiment of *Kitaoka* describes printing on a disk within a tray (see for example col. 4, ll. 3-5; ll. 18-20; col. 6, ll. 27-46; and col. 8, ll. 30-46), whereas every embodiment of *Kita et al.* uses a required pressure on each side of a disk in order to allow the transfer to take place. These two elements teach away from one another, as it is not possible using the discussed method and principle of operation of *Kitaoka*, namely printing in the disk tray, with the required two sided pressure printing method of *Kita et al.* Therefore, it is not proper to combine *Kitaoka* and *Kita et al.*, since under MPEP

2143.01, it is insufficient to show obviousness if the modification or combination of the prior art would change the principle of operation of the invention being modified.

Clearly, modifying Kitaoka, which has as an object printing in the tray, to print outside of the tray using a system requiring printing outside the tray, does not meet the requirements for an acceptable combination of the Kitaoka and Kita et al. references.

While a “general principle of using a transfer printing process” may be present in Kita et al., the mere presence is not sufficient to establish a motivation or suggestion to combine, especially since the combination would change the principle of operation of Kitaoka as is prohibited by MPEP 2143.01. Since the combination of Kitaoka and Kita et al. is improper, Applicant submits that claim 1 is allowable. Claims 2-3 and 7-10 depend directly or indirectly from and further define patentably distinct claim 1 and are also believed allowable.

Claim 12 also recites subject matter not present in any proper combination of Kitaoka and Kita et al., and is therefore believed allowable for the same reasons set forth for the allowance of claim 1. Claims 13-14 and 18-21 depend directly or indirectly from and further define patentably distinct claim 12 and are also believed allowable.

In order to state a *prima facie* case under 35 USC § 103, three criteria must be met. MPEP §2142 states in pertinent part:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The office action has failed to provide such a *prima facie* case. Claim 23 recites “forming a primary transfer image of plural colors on the intermediate transfer sheet *in a superimposed relation with the transferred positioning mark as a reference*” (emphasis added). Nowhere in Kita et al. or Kitaoka is such a superimposed relation shown, described, or suggested. Still further, the Office Action also contains no mention of where in Kitaoka or Kita et al. such an element appears. As such, the Office Action fails

to show where each and every element of claim 23 is present in the art, either alone or in combination, and as such claim 23 is not properly rejected, and should be allowed.

Claim 26 recites, in the context of a method of processing a compact disc, "prior to completing the transport of the CD to the printer, printing the image to an intermediate transfer sheet of the printer." Claim 30 recites "sequentially printing the images to an intermediate transfer sheet of a printer." The arguments set forth in support of the allowance of claim 1 apply to claims 26 and 30 as well. It is improper to combine Kitaoka and Kita et al. as such a combination would change the principle of operation of Kitaoka. As such, claims 26 and 30 are allowable.

Allowed Claims

Claims 4-6, 11, 15-17, 22, and 24-25 were allowed. Applicant thanks the Examiner for this indication.

CONCLUSION

Applicant believes that the claims are in condition for allowance and respectfully requests a withdrawal of the Final Rejection and a Notice of Allowance be issued in this case. If the Examiner has any questions regarding this application, please contact the undersigned at (612) 312-2203.

Respectfully submitted,

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